

REMARKS

Claims 11-13, 15, and 21-23 are currently active.

Claims 11, 13, 15, 21 and 22 have been amended. Antecedent support for the amendments to the claims is found in the figures and page 6, line 1.

Claim 23 has been added. Antecedent support for this claim is found in the figures and page 6, line 1.

The Examiner has suggested that the specification be amended in accordance with the disclosed proper format.

Accordingly, applicant has amended the specification in accordance with the disclosed proper format. The paragraphs added to pages 3 and 5 of the originally filed single spaced specification requested in applicant's amendment dated December 9, 1991 have been removed. Updated paragraphs in accordance with the newly amended claims have been added to pages 6 and 12 of the included double spaced copy of the original specification.

The specification is objected to under 35 U.S.C. §112, first paragraph, as failing to provide support for the claimed

invention. Claims 11-13, 15, 21-22 are also rejected for the same reasons.

The step of "transferring money", the phrase "second party financially distinct from the first party" and the phrase "said receiver in possession of the second party" recited in Claims 11 and 15 has been objected to by the Examiner, along with the steps of "telephoning" and "providing a credit card number" in Claim 22. Applicant respectfully disagrees with the Examiner. There is basis in the original specification for such language, which only defines "electronic sales" in terms that are well accepted to one skilled in the art.

In response to the Examiner's objection, applicant has respectfully submitted a Declaration Under 37 C.F.R. 1.132 essentially stating that the objectionable language is inherently provided by the originally filed disclosure. The term "electronically transferring of money" though not literally cited, is nonetheless equivalent in scope and function to the description of the invention as originally filed with respect to electronic sales.

The terms "electronically sell", "electronic sales" and "electronically sold" are used throughout the originally filed specification.

The originally filed (single spaced) "summary" section of the above-identified patent application states on page 2, line 8 that it "is an objective of the invention to provide a new and improved methodology/system to electronically sell and distribute" digital audio music. Further, page 2, last paragraph states that "electronic sales and distribution of music can take place via telephone lines onto a hard disc".

The originally filed "brief description of the drawings" section of applicant's originally filed specification states on page 3, last paragraph that the "hard disc 10 of the agent authorized to electronically sell and distribute the copyrighted digital audio music is the originating source as outlined in figure 1". Further, figure 1 clearly shows that the hard disc 10 communicates with the second parties system via telephone line 30.

Consequently, one skilled in the art, upon knowing that an object of the invention is "to electronically sell digital audio music" and that the hard disc 10, which communicates with the receiver through telephone lines 30, is authorized to electronically sell and distribute, would reasonably understand that a "transferring of money step" is naturally implied.

Electronic sales via telephone lines inherently assumes a transferring of money. Any "sale" by definition assumes a transference of money for a desired commodity, in this instance, digital audio or video signals.

In a similar argument, "electronic sales" over "telephone lines 30" are terms which encompass the well known process of "providing a credit card number" over a telephone line and "telephoning" to make the connection.

Thus, in summary, the present language of the claims to which the Examiner is objecting, has been added to more suitably describe the intended purpose of the applicant's invention. In no manner does it suggest or imply steps which are beyond the scope of the structure and methods described in the originally filed disclosure.

Applicant also brings to the Examiner's attention that for about 4 years, applicant has utilized the now questioned language in the claims and the Examiner has never questioned it. Only now, after 4 years does the Examiner raise a rejection based on the same. It was understood by applicant after the preliminary amendment filed on the parent application was responded to with an Office Action which did not raise an objection or rejection under 35 U.S.C. §112 concerning the

language, that the Examiner agreed with applicant the now questioned language just more specifically defines electronic sales. Applicant does not understand how after 4 years of Office Actions that this new issue suddenly is raised and that the Examiner has suddenly changed her position.

Accordingly, Claims 11-13, 15, 21 and 22 are patentable with respect to 35 U.S.C. §112.

The Examiner has requested a double spaced copy of the specification. Applicant has included a double spaced copy of the specification with this amendment. It should be noted that applicant had included a double spaced copy of the original specification with the amendment under Rule 116 dated August 21, 1990 in the parent case.

The specification is also objected to under 35 U.S.C. §112, first paragraph. The Examiner states that, as originally filed, it fails to provide clear support for the amendments to pages 3 and 5.

The amendments to pages 3 and 5 of the single spaced copy of the original application have been removed and similar but updated paragraphs have been added to the included double spaced copy of the original application. The paragraphs added to